

REMARKS

Claims 1-59 are pending. By this Amendment, claims 1-3, 5, 7, 13, 24, 26 and 41-45 are amended, and claims 51-59 are added. Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

The foregoing amendments are made for better clarification and/or to broaden the claims, and are not made in response to rejections set forth in the Office Action. It is believed that the rejections are in error, as discussed below.

Applicants thank Examiner Brown for the courtesies extended to Applicants' representative during the June 28, 2005 personal interview. The substance of the interview is incorporated in the following remarks.

I. The Election Requirement Is Improper

Applicants' November 1, 2004 Response to Election of Species Requirement explained why the September 30, 2004 Election Requirement is improper. The current Office Action provides no response to the points raised by Applicants relating to the election requirement. Applicants maintain that the requirement is improper for the reasons set forth previously. Because the Examiner has not rebutted Applicants' position, finality of the requirement is also improper.

The Office Action merely states that Applicants' traversal was "not found persuasive because the election was set forth based on different embodiments, claims and figures in the drawings." However, the assertion that the election was "set forth based on different embodiments, claims and figures" is incorrect. The Office Action only identified different claims (which is improper, as explained in Applicants' November 1, 2004 Response), and did not identify different embodiments and/or figures.

II. The Claims Define Patentable Subject Matter

A. The Office Action rejects claims 24-25, 34 and 40 under 35 U.S.C. §102(b) over U.S. Patent No. 4,969,472 to Langley et al. ("Langley"). This rejection is respectfully traversed.

Claim 24 recites, *inter alia*, a sheet member sized to fit entirely within a human eye socket. The claim is amended to better clarify that the term "entirely" may refer to one or more dimensions of the eye socket.

In contrast, as shown in Fig. 1 of Langley, the Langley eye patch does not fit entirely within a human eye socket, in any dimension. Rather, the Langley eye patch adheres to the facial area outside the eye socket, in all dimensions.

Additionally, it would not have been obvious to one of ordinary skill in the art to size the Langley eye patch to fit within the human eye socket, because doing so would be contrary to Langley's teachings. The Langley eye patch is intended for protecting a wearer's eye "during a post-surgery period or after injury to the eye" (column 1, lines 14-15). If the eye patch were sized to fit inside the eye socket, it would be difficult or impossible to apply the eye patch without putting some pressure, or risking putting some pressure, on the sensitive eye, which clearly would be undesirable for an eye that has been injured and/or surgically operated upon. Additionally, if the eye patch were sized to fit inside the eye socket, it could not properly be held in place by tape (shown in phantom in Fig. 1) or by an elastic headband encircling the patient's head (see column 3, lines 3-5) as taught by Langley.

Accordingly, claim 24 is patentably distinct from Langley. Claims 25, 34 and 40 are patentable at least for their dependence on claim 24. Withdrawal of this rejection is respectfully requested.

B. The Office Action rejects claims 26-33, 35-39, 45 and 50 under 35 U.S.C. §103(a) over Langley in view of U.S. Patent No. 4,867,146 to Krupnick et al. ("Krupnick")

and U.S. Patent No. 6,320,094 to Arnold et al. ("Arnold"). This rejection is respectfully traversed.

As explained above, sizing the Langley eye patch to fit inside a human eye socket would be contrary to the teachings of Langley. Therefore, regardless of the teachings of Krupnick and/or Arnold, or any other reference, one of ordinary skill in the art would not have been motivated to modify the Langley eye patch so that it fits inside a human eye socket. Therefore, neither Krupnick nor Arnold overcomes the deficiencies of Langley with respect to claim 24. Accordingly, claims 26-33, 35-39, 45 and 50 are allowable at least for their dependence on claim 24.

Additionally, the Office Action fails to set forth any motivation for the proposed combination of references with respect to various features recited in the dependent claims. For example, regarding the various thicknesses recited in the claims, the Office Action simply concludes, without any support or any reference to any teaching of the applied art, that "[t]he sheet and the metallic layer could be made of the same thickness as the dimensions recited in the claims, because the dimensions don't provide any novelty over the prior art." This analysis of the "thickness" features is clearly inadequate.

Similarly, with respect to various materials recited in the claims, the Office Action simply asserts that "[t]he metallic material could be any of the metallic materials recited in the claims because each material is old and well known." This analysis, too, is clearly inadequate. In general, most materials are "old" and/or "well known," but the Examiner is to consider such features in the context of the combination of features that is being claimed. It is well established that new combinations of "old" features are patentable.

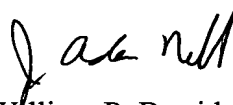
Accordingly, withdrawal of this rejection is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

J. Adam Neff
Registration No. 41,218

WPB:JAN/scg

Attachment:
Amendment Transmittal

Date: June 29, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
